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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,200	11/27/2000	Walid R. Tout	27751/04006	5193

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EXAMINER

TRAN, PHILIP B

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,200

Applicant(s)

TOUT, WALID R.

Examiner

Philip B Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-69 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-17, drawn to system and method of computer-to-computer data addressing, classified in class 709, subclass 245.

II. Claims 18-69, drawn to a system and method of data modifying, classified in class 709, subclass 246.

2. Inventions I, II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as system and method of transferring address data in the network to ensure that data are transferred to or from the intended computers, classified in a different Class/Subclass. Invention II has separate utility such as changing the format of the data with symbols transferred between the computers, classified in a different Class/Subclass. See MPEP § 806.05(d).

3. The inventions are distinct, each from the other, because of the following reasons:

(a) These inventions have acquired a separate status in the art as shown by their different classifications.

(b) The search required for each Group is different and not co-extensive for examination purposes.

For example, the searches for the two inventions would not be co-extensive because these Groups would require different searches on PTO's classification class and subclass as following :

the Group I search (claims 1-17) would require use of search Class 709, subclass 245 (not require for the invention II).

the Group II search (claims 18-69) would require use of search Class 709, subclass 246 (not require for the invention I).

For the reasons given above restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (i).

6. During a telephone conversation with Mr. Neil G. Cohen (Reg. No. 35,100), on 12/09/03 a provisional election was made with traverse to prosecute the invention of Group II, claims 18-69. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-17 withdrawn from consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 U.S.C. § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 18-69 are rejected under 35 U.S.C. § 102(a/b) as being anticipated by publication iDNS-Internationalized Domain Name System published by the Center for Internet Research, January 1998 (Hereafter, CIR).

Regarding claim 18, CIR teaches a method for producing a domain name, wherein the domain name includes only symbols from a set of allowed symbols, comprising the steps of :

(a) obtaining a second domain name, wherein the second domain name includes at least one symbol that is not included in the set of allowed symbols (i.e., working with existing DNS and analyzing/translating international domain names) [see Page 2];

(b) converting the second domain name into a format that includes only symbols from the set of allowed symbols (i.e., converting multilingual text to ASCII) [see Page 3]; and

(c) automatically appending a redirector string to the converted second domain name to produce the domain name, wherein the redirector string includes information for resolving the domain name (i.e., appending of the redirector string to the domain name) [see Page 3, Notes section].

Regarding claim 19, CIR further teaches the method of claim 18, wherein step (c) comprises automatically appending a predetermined string to the converted second domain name to produce the domain name (i.e., appending of the predetermined string to the domain name) [see Page 3].

Regarding claim 20, CIR further teaches the method of claim 18, wherein step (c) comprises automatically appending at least one domain level to the converted second domain name to produce the domain name (i.e., generic top level domains) [see Page 3].

Regarding claim 21, CIR further teaches the method of claim 18, wherein the set of allowed symbols comprises the uppercase letters A-Z, the lowercase letters a-z, and the hyphen/minus sign (i.e., allowed symbols) [see Page 1, bottom paragraph].

Regarding claim 22, CIR further teaches the method of claim 18, wherein the set of allowed symbols comprises symbols specified in RFC 1035 [see Page 1, bottom paragraph].

Regarding claim 23, CIR further teaches the method of claim 18, further comprising the step of (d) transmitting the domain name to a domain name server so that the domain name server can provide information corresponding to the domain name [see Figure on Page 2].

Regarding claims 24-26, CIR further teaches the method of claim 23, wherein step (d) comprises transmitting the domain name to the domain name server so that the domain name server can provide an Internet protocol number corresponding to the domain name and (e) transmitting at least a portion of the domain name to a root server so that the root server can provide Internet protocol number corresponding to the domain name (i.e., DNS servers are used in relation with Internet which makes use of domain names as well such as ftp, email, etc and for resolving domain names which are inherently suggested of providing IP number and transmitting at least a portion of the domain name to a root server) [see Pages 1 & 2 and Figure on Page 2].

Claim 27 is rejected under the same rationale set forth above to claim 23.

Regarding claim 28, CIR further teaches the method of claim 18, wherein step (a) is transparent to a user (i.e., working with existing DNS and analyzing/translating international domain names) [see Page 2]. Since the software does the analyzing/translating, such analysis/translation will be transparent to the user.

Regarding claim 29, CIR teaches a method for producing a domain name, wherein the domain name is in a first format comprising the steps of :

(a) obtaining a plurality of symbols, wherein via plurality of symbols are in a second format, and wherein the second format is different from the first format (i.e., working with existing DNS and analyzing/translating international domain names wherein multilingual texts are different from ASCII) [see Pages 1-2];

(b) converting the plurality of symbols into a second plurality of symbols, wherein the second plurality of symbols are in the first format (i.e., converting multilingual text to ASCII) [see Page 3]; and

(c) automatically appending a redirector string to the second plurality of symbols to produce the domain name, wherein the redirector string includes information for resolving the domain name (i.e., appending of the redirector string to the domain name) [see Page 3, Notes section].

Regarding claim 30, CIR further teaches the method of claim 29, wherein step (c) comprises automatically appending a predetermined string to the second plurality of

symbols to produce the domain name (i.e., appending of the predetermined string to the domain name) [see Page 3].

Regarding claim 31, CIR further teaches the method of claim 29, wherein step (c) comprises automatically appending at least one domain level to the second plurality of symbols to produce the domain name (i.e., generic top level domains) [see Page 3].

Regarding claim 32, CIR further teaches the method of claim 29, wherein the first format includes symbols comprising the uppercase letters A-Z, the lowercase letters a-z, and the hyphen/minus sign (i.e., allowed symbols) [see Page 1, bottom paragraph].

Regarding claim 33, CIR further teaches the method of claim 29, wherein the first format includes symbols allowed by RFC 1035 and the second format includes symbols that are not allowed by RFC 1035 [see Page 1, bottom paragraph and Page 3].

Regarding claim 34, CIR further teaches the method of claim 29, further comprising the step of (d) transmitting the domain name to a domain name server so that the domain name server can provide information corresponding to the domain name [see Figure on Page 2].

Regarding claims 35-37, CIR further teaches the method of claim 34, wherein step (d) comprises transmitting the domain name to the domain name server so that the

domain name server can provide an Internet protocol number corresponding to the domain name and (e) transmitting at least a portion of the domain name to a root server so that the root server can provide Internet protocol number corresponding to the domain name (i.e., DNS servers are used in relation with Internet which makes use of domain names as well such as ftp, email, etc and for resolving domain names which are inherently suggested of providing IP number and transmitting at least a portion of the domain name to a root server) [see Pages 1 & 2 and Figure on Page 2].

Claim 38 is rejected under the same rationale set forth above to claim 34.

Regarding claim 39, CIR further teaches the method of claim 29, wherein step (a) is transparent to a user (i.e., working with existing DNS and analyzing/translating international domain names) [see Page 2]. Since the software does the analyzing/translating, such analysis/translation will be transparent to the user.

Claim 40 is rejected under the same rationale set forth above to claim 18.

Claims 41-42 are rejected under the same rationale set forth above to claims 19-20, respectively.

Regarding claim 43, CIR teaches a method for providing information that corresponds to a domain name, wherein the domain name includes only symbols from a set of allowed symbols, comprising the steps of :

- (a) receiving the domain name, wherein the domain was produced by
 - i. obtaining a second domain name, wherein the second domain name includes at least one symbol that is not included in the set of allowed symbols (i.e., working with existing DNS and analyzing/translating international domain names) [see Page 2];
 - ii. converting the second domain name into a format that includes only symbols from the set of allowed symbols (i.e., converting multilingual text to ASCII) [see Page 3]; and
 - iii. automatically appending a redirector string to the converted second domain name to produce the domain name, wherein the redirector string includes information for resolving the domain name (i.e., appending of the redirector string to the domain name) [see Page 3, Notes section]; and
- (b) submitting the domain name to a database so that the information can be provided [see Page 2].

Regarding claim 44, CIR further teaches the method of claim 43, wherein (a) the second domain name includes at least three domain levels and (b) the domain name includes only two domain levels [see Page 3, Generic top level domains].

Regarding claim 45, CIR further teaches the method of claim 43, wherein the information comprises an Internet protocol number (i.e., DNS servers are used in relation with Internet which makes use of domain names as well such as ftp, email, etc and for resolving domain names which are inherently suggested of providing IP number

and transmitting at least a portion of the domain name to a root server) [see Pages 1 & 2 and Figure on Page 2].

Regarding claim 46, CIR further teaches the method of claim 43, wherein step (a)(i) is transparent to a user (i.e., working with existing DNS and analyzing/translating international domain names) [see Page 2]. Since the software does the analyzing/translating, such analysis/translation will be transparent to the user.

Claim 47 is rejected under the same rationale set forth above to claim 18.

Claim 48 is rejected under the same rationale set forth above to claim 19.

Regarding claim 49, CIR further teaches the method of claim 47 wherein step (a) comprises receiving the second domain name by a software program loaded on a computer of a user (i.e., browser) [see Page 3].

Regarding claim 50, CIR teaches a method for producing a domain name, comprising the steps of :

(a) receiving a plurality of symbols, wherein the plurality of symbols are in a first format (i.e., working with existing DNS and analyzing/translating international domain names) [see Pages 1-2];

(b) converting the plurality of symbols into a second plurality of symbols, wherein the second plurality of symbols are in a second format, wherein the first format is

different from the second format (i.e., converting multilingual text to ASCII wherein multilingual texts are different from ASCII) [see Page 3]; and

(c) automatically appending a redirector string to the second plurality of symbols to produce the domain name, wherein the redirector string includes information for resolving the domain name (i.e., appending of the redirector string to the domain name) [see Page 3, Notes section].

Regarding claim 51, CIR further teaches the method of claim 50, wherein step (c) comprises automatically appending a predetermined string to the second plurality of symbols to produce the domain name (i.e., appending of the predetermined string to the domain name) [see Page 3].

Regarding claim 52, CIR further teaches the method of claim 50, wherein step (a) comprises receiving the second plurality of symbols by a software program loaded on a computer of a user (i.e., browser) [see Page 3].

Regarding claim 53, CIR teaches a method for resolving a domain name, comprising the steps of :

(a) receiving a first plurality of symbols by a first software program, wherein the first plurality of symbols are in a first format (i.e., working with existing DNS and analyzing/translating international domain names) [see Pages 1-2];

(b) transmitting the first plurality of symbols from the first software program to a second software program, wherein the second software program includes instructions for

i. converting the first plurality of symbols into a second plurality of symbols, wherein the second plurality of symbols are in a second format, wherein the first format is different from the second format (i.e., converting multilingual text to ASCII wherein multilingual texts are different from ASCII) [see Page 3]; and

ii. automatically appending a redirector string to the second plurality of symbols to produce the domain name, wherein the redirector string includes information for resolving the domain name (i.e., appending of the redirector string to the domain name) [see Page 3, Notes section]; and

(c) transmitting the domain name from the second software program to a third software program, wherein the third software program includes instructions for i) transmitting the domain name to a server and ii) receiving from the server in response thereto information corresponding to the domain name [see Page 2 and Figure on Page 2].

Regarding claim 54, CIR further teaches the method of claim 53, wherein step, (b)(ii) comprises automatically appending at least one domain level to the second plurality of symbols to produce the domain name [see Page 3, Notes section and Generic top level domains] .

Regarding claim 55, CIR further teaches the method of claim 53, wherein step (c)(ii) comprises receiving from the server in response to the transmission of the domain name an Internet protocol number corresponding to the domain name (i.e., DNS servers are used in relation with Internet which makes use of domain names as well such as ftp, email, etc and for resolving domain names which are inherently suggested of receiving IP number and transmitting at least a portion of the domain name to a root server) [see Pages 1 & 2 and Figure on Page 2].

Claim 56 is rejected under the same rationale set forth above to claim 50.

Regarding claim 57, CIR further teaches the device of claim 56, wherein the second format specifies only symbols from a set of allowed symbols (i.e., ASCII) and the first format specifies at least one symbol that is not included in the set of allowed symbols (i.e., multilingual texts) [see Page 1 and Page 3].

Regarding claim 58, CIR further teaches the device of claim 56, wherein the redirector string comprises at least one domain level [see Page 3, General top level domains].

Regarding claim 59, CIR teaches a method for producing a domain name, wherein the domain name includes only symbols from a set of allowed symbols, comprising the steps of :

(a) converting a second domain name, which includes at least one symbol that is not included in the set of allowed symbols, into a format that includes only symbols from the set of allowed symbols (i.e., converting multilingual texts to ASCII) [see Page 1 and Page 3]; and

(b) automatically appending a redirector string to the converted second domain name to produce the domain name, wherein the redirector string includes information for resolving the domain name (i.e., appending of the redirector string to the domain name) [see Page 3, Notes section].

Regarding claim 60, CIR further teaches the method of claim 59, wherein the redirector string indicates that the domain name is an international domain name (i.e., multilingual domain names) [see Page 3].

Regarding claim 61, CIR further teaches the method of claim 59, wherein the redirector string comprises at least one domain level [see Page 3, General top level domains].

Regarding claim 62, CIR teaches a method for producing a domain name, comprising the steps of :

(a) converting a first plurality of symbols into a second plurality of symbols, wherein the first plurality of symbols are in a first format, wherein the second plurality of symbols are in a second format, and wherein the first format is different from the second

format (i.e., converting multilingual texts to ASCII wherein multilingual texts are different from ASCII) [see Page 3]; and

(b) automatically appending a redirector string to the second plurality of symbols to produce the domain name, wherein the redirector string includes information for resolving the domain name (i.e., appending of the redirector string to the domain name) [see Page 3, Notes section].

Regarding claim 63, CIR further teaches the method of claim 62, wherein the redirector string indicates that the domain name is an international domain name (i.e., multilingual domain names) [see Page 3].

Regarding claim 64, CIR further teaches the method of claim 62, wherein the redirector string comprises at least one domain level [see Page 3, General top level domains].

Regarding claim 65, CIR further teaches the method of claim 62, wherein the second format includes symbols allowed by RFC 1035 and the first format includes symbols that are not allowed by RFC 1035 [see Page 1 and Page 2].

Regarding claim 66, CIR teaches a method for providing information that corresponds to a domain name, comprising the steps of :

(a) receiving the domain name (i.e., working with existing DNS and analyzing/translating international domain names) [see Pages 1-2], wherein the domain was produced by

i. converting a second domain that includes at least one symbol that is not included in a set of allowed symbols name into a format that includes only symbols from the set of allowed symbols (i.e., converting multilingual texts to ASCII) [see Page 1 and Page 3]; and

ii. automatically appending a redirector string to the converted second domain name to produce the domain name, wherein the redirector string includes information for resolving the domain name (i.e., appending of the redirector string to the domain name) [see Page 3, Notes section]; and

(b) submitting the domain name to a database so that the information can be provided [see Page 2].

Regarding claim 67, CIR further teaches the method of claim 66, wherein (a) the second domain name includes at least three domain levels and (b) the domain name includes only two domain levels [see Page 3, General top level domains].

Regarding claim 68, CIR further teaches the method of claim 66, wherein the redirector string indicates that the domain name is an international domain name (i.e., multilingual domain names) [see Page 3].

Regarding claim 69, CIR further teaches the method of claim 66, wherein the redirector string comprises at least one domain level [see Page 3, General top level domains].

Other References Cited

9. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

A) Tan et al, U.S. Pat. No. 6,314,469.

B) Tan et al, U.S. Pat. No. 6,446,133.

10. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS, OR THIRTY DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (703) 308-8767. The Group fax phone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (703) 308-6662.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

PBT

Philip B. Tran
Art Unit 2155
December 09, 2003

Hosain Alam

HOSAIN ALAM
ASSISTANT PATENT EXAMINER